

Applicant : Simon M. Furnish  
Serial No. : 10/037,307  
Filed : December 31, 2001  
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Attorney's Docket No.: 12258-031001 / InfraReDx-12

## REMARKS

### Amendments to specification

Applicant amends the specification to include an application serial number that was not available at the time the application was filed.

### Drawings

Applicant submits herewith formal drawings to replace the originally filed drawings.

### IDS

On November 6, 2003, Applicant filed an information disclosure statement to draw attention to art identified in a corresponding foreign application. The office action does not include an initialed copy of the Form 1449 submitted with that IDS. Applicant requests that this be included with the next communication from the Patent Office.

### Change of address

Applicant's attorney filed a revocation of power-of-attorney and a new power-of-attorney on July 2, 2003. However, the office action was sent to the earlier attorney-of-record, thereby causing an unnecessary delay in prosecution.

Applicant requests that further communication from the Patent Office be sent to the address below. To assist the Patent Office in doing so, Applicant submitted a request for change of address on February 19, 2004.

### Section 102 rejection of claims 1 and 38

Applicant draws attention to claim 1's limitation that the elongated housing have "annularly disposed elongated *grooves* arranged thereon" and that the flexible energy bearing members are "arranged in each of said elongated *grooves*."

FIGS. 3 and 4 of *Davies*<sup>1</sup> clearly show that the fibers in the *Davies* catheter are inside tubes, not grooves. Moreover, the cited language on column 2, lines 12-23 only states that the

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<sup>1</sup> *Davies*, U.S. Patent No. 4,672,961.

catheter 10 has circumferentially spaced optical fibers 19. It does not say anything to contradict what is shown in FIGS. 3 and 4.

The distinction between placing the fibers in grooves, as recited in claim 1, and inserting them into tubes, as shown in *Davies*, is a distinction with a difference. For example:

(1) Inserting a fiber into a tube is like threading a needle, only more difficult because a tube is not an eye. It is much easier to simply nestle the fiber into a groove.

(2) Tubes in molded parts often result in knit lines. These knit lines can compromise accuracy of part placement and material strength. Grooves, on the other hand, are unlikely to cause knit lines.

(3) Placing the fibers in grooves permits the resulting catheter to have a smaller overall profile because there is no need to provide additional material to bury the fibers.

Applicant submits that *Davies* fails to disclose or suggest a catheter in which fibers are placed in grooves as required by claim 1. Accordingly, Applicant requests withdrawal of the section 102 rejection of claim 1, and all claims dependent thereon.

Claim 38 recites similar limitations. Accordingly, Applicant also requests withdrawal of the section 102 rejection of claim 38 and all claims dependent thereon.

### **Section 103 of claim 25**

Like claims 1 and 38, claim 25 includes the limitation of a housing with “elongated grooves arranged thereon” and a fiber “in each of said elongated grooves.” For reasons discussed above, *Davies* fails to disclose this limitation.

The additional reference *Mueller* fails to disclose this missing limitation. Therefore, the combination of *Davies* and *Mueller* cannot amount to the claimed invention because neither *Davies* nor *Mueller* disclose or suggest at least one claim limitation. Accordingly, Applicant requests reconsideration and withdrawal of the section 103 rejection of claim 25 and all claims dependent thereon.

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### Summary

Now pending in this application are claims 1-42, of which claims 1, 25, and 38 are independent. No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, please adjust our deposit account 06-1050, referencing attorney docket number "12258-031001".

Respectfully submitted,

Date: 4/21/04



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